

P21513.A06



Application No. 09/964,653

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants : Tae Kyun KIM et al.

Group Art Unit : 2839

Appl No. : 09/964,653

Examiner : Khiem NGUYEN

Filed : September 28, 2001

For : FLUORINATED POLYETHERS HAVING PERFLUORINATED
ALIPHATIC GROUP AND OPTICAL WAVEGUIDE USING THE SAME

ELECTION WITH TRAVERSE

Commissioner of Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

This is in response to the requirement for restriction under 35 U.S.C. 121 mailed from the U.S. Patent and Trademark Office on January 28, 1004, which sets a one month period for response until February 28, 2004.

Applicants hereby request an extension of time for one month to extend the period for filing an Election to the Restriction Requirement until March 29, 2004 (March 28, 2004 being a Sunday), and are concurrently filing a formal Request for Extension of Time for one month accompanied by the government fee. If for any reason the formal Request for Extension of Time is not associated with the file at the Patent and Trademark Office and/or any fees are necessary for maintaining the pendency of this application, Applicants hereby respectfully request any necessary extension of time and hereby authorize that any required fee to maintain the pendency of the application be charged to Deposit Account No. 19-0089.

Reconsideration and withdrawal of the requirement for restriction are respectfully requested in view of the remarks which follow:

RESTRICTION REQUIREMENT

The Examiner has required restriction to one of the following inventions under 35 U.S.C. 121:

- I. Claims 1-5, drawn to a fluorinated polyether, classified in class 528, subclass 219.
- II. Claim 6, drawn to optical waveguide device, classified in class 385, subclass 129.

ELECTION

In order to be responsive to the requirement for restriction, Applicants elect the invention set forth in Group I, claims 1-5, with traverse.

TRAVERSE

Notwithstanding the election of the claims of Group I in order to be responsive to the Restriction Requirement, Applicants respectfully traverse the Examiner's requirement for restriction.

Initially, it is noted that the requirement for restriction omits one of the two criteria of a proper requirement as now established by U.S. Patent and Trademark Office policy, as set forth in MPEP 803, viz. that "an appropriate explanation" must be advanced by the Examiner as to the existence of a "serious burden" if a restriction were not required. Due to the aforementioned omission, it is respectfully submitted that the requirement for restriction is improper and, consequently, its withdrawal is respectfully requested.

Related to this, the requirement is traversed since there would not appear to be a serious burden to examine Applicants' application in total, and for which the appropriate claim fees have been paid. Applicants submit that it would be no serious burden on the Examiner to examine all of the pending claims, because a search for all of the claims in the above-identified application, should be made in order to do a complete and thorough search in view of the recognized relationship between the claims in Groups I and II. In particular, the waveguide type optical devices recited in the Group II claims include the fluorinated polyethers recited in the claims of Group I.

Moreover, Applicants respectfully submit that the claims in Groups I and II are related as combination/subcombination, and cannot be restricted unless two way distinctness can be shown. In particular, the claims of Group I are directed to the subcombination of the recited fluorinated polyethers, and the claims of Group II are directed to the combination comprising waveguide type optical devices wherein the core and/or cladding layers are formed of the fluorinated polyethers of the claims of Group I. The Examiner is reminded that where, as is the present situation, **the combination/subcombination has the relationship of AB_{sp}/B_{sp} restriction is not proper.** In

this regard, the Examiner's attention is directed to MPEP 806.05(c), especially numbered section II, wherein the criteria for restriction is set forth for combination/subcombination inventions and a similar example to that of the instant claims is provided. Accordingly, the requirement is improper for this reason.

In view of the foregoing, it is respectfully requested that the Examiner seriously reconsider the requirement for restriction, and withdraw the same so as to give an examination on the merits on all of the claims pending in this application. In any event, the non-elected claims should be rejoined upon allowance of the elected claims of Group I.

CONCLUSION

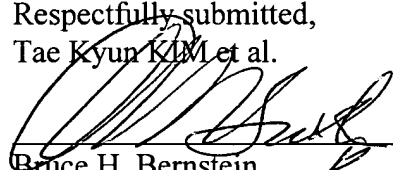
For the reasons discussed above, it is respectfully submitted that the requirement for restriction is improper and should be withdrawn.

Withdrawal of the requirement for the restriction with the examination of all claims pending in this application is respectfully requested.

Favorable consideration with early allowance of the pending claims is most earnestly requested.

If the Examiner has any questions, or wishes to discuss this matter, please call the undersigned at the telephone number indicated below.

Respectfully submitted,
Tae Kyun KIM et al.


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